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OFFICE OF PETITIONS

In re Application of :
Hirohiko Itoh :
Application No. 09/322,177 : ON PETITION
Filed: 28 May, 1999 :
Atty Docket No. 35.G1549-CI :

This is a decision on the petition under 37 CFR 1.182, filed on 22 June, 2004, requesting entry of an amendment to the specification to insert a reference to an earlier-filed application pursuant to the provisions of 35 U.S.C. § 120.

The Office apologizes for the delay in responding to the present petition.

The petition is **DISMISSED**.

The record discloses that a request for a Continued Prosecution Application (CPA) was filed on 4 October, 2002. Pursuant to the provisions of 37 CFR 1.53(d)(1)(v), a request for a CPA is a request to expressly abandon the prior application as of the filing date of the request. A request for a CPA is the specific reference required by 35 U.S.C. § 120 to every application assigned the application number; however, the prior application failed to make a specific reference to the prior-filed application, namely Application No. 08/528,423, filed on 12 March, 1998, prior to the abandonment thereof. Petitioner now requests that the prior abandoned application be amended by inserting a reference to the earlier-filed applications. On 16 June, 2004, the issue fee in the present application was paid. On 22 June, 2004, petitioner filed an amendment to include a reference to the prior-filed application in the first line of the specification following the title of the invention.

35 U.S.C. § 120 permits entry of a subsequent amendment to an abandoned application in applications filed prior to 29 November,

2000, to include the benefit of an earlier filing date for purposes other than prosecution.¹

The petition must be dismissed, however, because the issue fee was paid 16 June, 2004, prior to the filing of the amendment on 22 June, 2004. Pursuant to 37 CFR 1.312, no amendments may be entered after payment of the issue fee.²

Petitioner may wish to consider filing a request to withdraw the application from issue and a Request for Continued Examination, along with a submission under 37 CFR 1.114.

The petition fee of \$130.00 has been charged to counsel's deposit account, No. 06-1205, as authorized in the present petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 272-3231
 Attn: Office of Petitions

By hand: Customer Service Window
 Mail Stop Petition
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.



Douglas I. Wood
Senior Petitions Examiner
Office of Petitions

¹ See Sampson v. Commissioner of Patents and Trademarks, 195 USPQ 136 (D.C.D.C. 1976).

² 37 CFR § 1.312. No amendment may be made as a matter of right in an application after the mailing of the notice of allowance. **Any amendment filed pursuant to this section must be filed before or with the payment of the issue fee**, and may be entered on the recommendation of the primary examiner, approved by the Director, without withdrawing the application from issue. Id (Emphasis added).